

REMARKS

Prior to entry of this amendment, Claims 1-32 were pending in this application, with Claims 1-12 and 24-32 withdrawn from consideration. No claims are added or canceled. Hence, Claims 1-32 are presently pending in this application, with Claims 13-23 currently under examination.

OVERVIEW OF CLAIM 13

Router interface information is read from a router configuration file, through which a sub-network on a LAN interface is used to determine a “site” for network directory service purposes and a WAN interface is used to determine “site links” for network directory service purposes. These determinations are fundamental to the process of “automatically generating network site and site link information from a router configuration file for use in a directory service,” as recited in Claim 13 and as described in detail throughout the application.

REJECTION NOT BASED ON PRIOR ART

Rejection under 35 U.S.C. §112, second paragraph

The Office Action (“Action”) rejected Claims 13-23 under 35 U.S.C. §112, second paragraph, as allegedly indefinite. This rejection of Claims 13-23 is traversed.

This rejection appears to be based on the rationale that Claims 13-23 are allegedly indefinite because of their recitation of the terms “Local Area Network (LAN)” and “Wide Area Network (WAN)” to claim an alternative approach in which LAN and WAN interfaces read from a router configuration file are used for the purposes of generating site and site link references. More specifically, the Action seems to allege that Claims

13-23 are indefinite because the alternative approach described in the application defines an interface as a LAN interface if the then-current bandwidth of a router interface exceeds a pre-determined threshold value and assuming interfaces having lower bandwidth are WAN interfaces, which contradicts what the Action contends is “the accepted meaning” that a WAN has greater bandwidth than a LAN.

First, WANs do not necessarily, nor by definition, enable a greater bandwidth than LANs. It is entirely possible for LANs on corporate campuses to use Gigabit Ethernet links and to use lower-bandwidth T1 links to interconnect the campuses (i.e., as a WAN link). Such a network architecture is fully appropriate when little data travels between campuses. Thus, both an architecture implied in the alternative approach that is described in the specification and referenced in the Action (e.g., the foregoing example), and an approach in which a WAN has greater bandwidth than a LAN (as presented in the Action), are equally valid and realistic approaches.

Next, regardless of whether or not the “accepted meaning” set forth in the Action is what one skilled in the art would understand with respect to LANs and WANs, in the description of the alternative approach Applicants are not attempting to redefine a LAN or a WAN, but merely describing assumptions that are made in an alternative embodiment of the invention. That particular alternative embodiment utilizes such assumptions as a matter of design choice in characterizing certain network entities as either a “site” or a “site link” for use in a directory service, such as the Active Directory service. These are simply assumptions that can be made as an alternative to identifying a LAN interface based on the interface being a Fast Ethernet, Ethernet, FDDI, VLAN, Gigabit Ethernet, Token Ring, or other well-known LAN technology; and as an

alternative to identifying a WAN interface based on the interface being a ATM, POS, Serial, HSSI, FR-ATM, Tunnel, CBR, or other well-known WAN technology (specification paragraphs [0045]-[0047]).

The Board of Patent Appeals and Interferences has stated

In rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989) (citing *In re Moore*, 439 F.2d 1232 (C.C.P.A. 1971).

The Court of Appeals for the Federal Circuit has similarly stated that the law is clear that if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985).

Therefore, the description of the alternative approach in the specification does not make Claim 13 indefinite because Claim 13 is clear and definite in reciting that site references and site link references are generated by identifying, from router interface information from a router configuration file, a sub-network on a LAN interface (e.g., a “site”) and a WAN interface (e.g., a “site link”). Whether LAN and WAN interfaces are identified (1) based on identification of specific well-known LAN and WAN technologies, or, alternatively (2) based on the assumptions described, could be a matter of choice or a matter of necessity based on what information is available from the router for a given implementation of Claim 13. However, a claim that may encompass

alternative approaches that are described in the application does not make the claim indefinite under the meaning of 35 U.S.C. §112, second paragraph.

Because (1) LANs and WANs do not in fact have a necessary bandwidth-based relationship; (2) LANs and WANs are not claimed, *per se*; and (3) the claim encompasses multiple approaches to identifying LAN and WAN interfaces, one skilled in the art is “able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by” and is “reasonably apprised of the scope of” Claim 13 even if the scope of the claim encompasses alternative approaches. For the foregoing reasons, a *prima facie* case of indefiniteness is not established in the Action and withdrawal of the rejection of Claims 13-23 under 35 U.S.C. §112 is requested.

REJECTIONS BASED ON PRIOR ART

Rejection under 35 U.S.C. §102(b)

The Office Action rejected Claim 13 under 35 U.S.C. §102(b) as allegedly anticipated by Wheeler et al. (“*Wheeler*”; U.S. Patent No. 6,009,081). This rejection of Claim 13 is traversed.

For a proper anticipation rejection, a reference must show each and every feature of a claim in the same combination as claimed. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). *Wheeler* does not disclose, explicitly or implicitly, all of the features recited in Claim 13. In fact, *Wheeler* does not appear to disclose *any* of the features recited in Claim 13.

The citations of *Wheeler* (col. 10, lines 7-17 and line 54; Fig. 4; col. 9, lines 15-22) that allegedly anticipate Claim 13 do not disclose (1) **automatically generating**

network site and site link information (2) from a router configuration file (3) for use in a directory service, as recited in Claim 13. Furthermore, *Wheeler* surely does not disclose the specific actions recited in Claim 13, such as **(4) reading override information for nullifying information, from router configuration files, associated with site or site links; and (5) reading router interface information from a router configuration file to generate site and site link references**. The prior art citations relied upon merely refer to LANs, a router's FDDI LAN interface, and WANs in a specific context that is not even remotely related to the context featured in Claim 13. Furthermore, Claim 13 is not claiming LANs, WANs or interconnecting routers, *per se*. Rather, Claim 13 in part recites a specific use of router configuration files that provide LAN and WAN interface information.

Due to the deficiencies in the disclosure of *Wheeler*, as summarized above, *Wheeler* cannot and does not anticipate Claim 13. Therefore, a prima facie case of anticipation is not established in the Action, and withdrawal of the rejection of Claim 13 under 35 U.S.C. §102 is requested.

Rejections under 35 U.S.C. §103(a)

Claim 14

The Office Action rejected Claim 14 under 35 U.S.C. §103(a) as allegedly unpatentable over *Wheeler*. This rejection of Claim 14 is traversed.

Because Claim 14 depends from Claim 13, Claim 14 is patentable over *Wheeler* for at least the same reasons described in reference to Claim 13, where it is shown that *Wheeler* does not disclose the method recited in Claim 13. Furthermore, *Wheeler* does not suggest or motivate the method recited in Claim 14.

The Action does not present a rational reason and there is no reason to believe that one skilled in the art would be motivated to modify *Wheeler* to **automatically generate network site and site link information for use in a directory service**, as recited in Claim 14. The rationale presented in the Action is fundamentally flawed. Simply repeating a stated purpose of an entity described in a prior art reference does not logically equate to a motivation to modify the teachings of the reference for a purpose, as recited in the claim, that is not related to that stated purpose and not remotely disclosed or suggested in the reference. The *Wheeler* reference does not come close to addressing the problem(s) solved by the invention recited in Claim 14, as generally characterized in the Background section of the application.

As the Court of Appeals for the Federal Circuit (CAFC) has repeatedly held, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). The Action goes even further in its application of hindsight, by merely alleging that one skilled in the art would be motivated to modify *Wheeler* to perform certain steps that are not disclosed, suggested or motivated by *Wheeler*, for a purpose that is not relevant to the recited use of the certain steps in the claim being rejected, i.e., Claim 14.

The foregoing proves that a prima facie case of obviousness is not established in the Action, and cannot be supported by the disclosure of *Wheeler*. Hence, Claim 14 is patentable over *Wheeler*, and withdrawal of this rejection of Claim 14 under 35 U.S.C. §103 is requested.

Claims 15-17

The Office Action rejected Claims 15-17 under 35 U.S.C. §103(a) as allegedly unpatentable over *Wheeler* in view of Ecklund (“*Ecklund*”; U.S. Patent No. 4,853,843). This rejection of Claims 15-17 is traversed.

Because Claims 15-17 depend from Claims 13 and 14, the disclosure of *Wheeler* is deficient in its support of a valid obviousness rejection of Claims 15-17 for at least the same reasons described in reference to Claims 13 and 14.

In addition, the Action does not present a rational reason and there is no reason to believe that one skilled in the art would be motivated to combine *Wheeler* and *Ecklund* to **automatically generate network site and site link information for use in a directory service**, as recited in the subject claims. Furthermore, regardless of whether a motivation to combine *Wheeler* and *Ecklund* exists, a combination of these references simply would not result in the methods recited in Claims 15-17, because the references do not teach or suggest automatically generating network site and site link information for use in a directory service. Still further, neither of the cited references discloses, suggests or motivates **reading router interface information from a router configuration file** according to the specific process and for the specific purpose that is featured in Claims 15-17.

As with Claim 14, simply repeating a stated purpose described in a prior art reference does not logically equate to a motivation to modify the teachings of the reference for a purpose that is not related to that stated purpose and not disclosed or suggested in the reference. Neither the *Wheeler* nor the *Ecklund* references address the problem(s) being solved by the invention recited in each of Claims 15-17.

The foregoing proves that a prima facie case of obviousness was not established, and cannot be supported and sustained by the disclosures of *Wheeler* and *Ecklund*. Hence, Claims 15-17 are patentable over the references of record, and withdrawal of this rejection of these claims under 35 U.S.C. §103 is requested.

CONCLUSION

For at least the reasons indicated above, Applicants submit that all of the pending claims currently under consideration (13-23) present patentable subject matter over the references of record, and are in condition for allowance. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner has questions regarding this case, the Examiner is invited to contact Applicant's undersigned representative.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully Submitted,

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